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NEW YORK NY 10036

In re Application of
ENGELHARDT et al.
Application No.: 10/532,779
Attorney Docket No.: 188.574
For: FINGER LEVER OF A VALVE TRAIN OF
AN INTERNAL COMBUSTION ENGINE

NOTIFICATION

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371.

BACKGROUND

On 14 October 2003, applicant filed international application PCT/EP03/11343, which designated the U.S. and claimed a priority date of 24 October 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 25 April 2005 (24 April 2005 being a Sunday).

On 22 April 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee; authorization to charge any additional fees or credit any overpayment to Deposit Account No. 02-2275; a preliminary amendment and a purported translation into English of the international application. The preliminary amendment indicates that the "application is a Continuation of PCT/EP03/11343 filed October 14, 2003."

On 12 August 2005, applicants filed a petition under 37 CFR 1.47(a).

On 30 September 2005, applicants filed a declaration of inventors signed by all of the inventors.

On 13 February 2006, a decision was mailed indicating that the petition under 37 CFR 1.47(a) was moot in view of the declaration filed 30 September 2005. The decision also indicated that the application was being forwarded to the national stage office for preparation of a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) showing a 35 U.S.C. 371 date of 30 September 2005.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter filed on 22 April 2005 identified the application as "a filing under 35 U.S.C. 371." However, the preliminary amendment amended the first line of the specification to read "[t]his application is a Continuation of PCT/EP03/11343 filed October 14, 2003." Applicant's reference in the disclosure to benefit of the international application under 35 U.S.C. § 120 in the first sentence of the specification is inconsistent with the transmittal letter filed 22 April 2005 and contradicts the request in the transmittal letter to file under 35 U.S.C. 371. See, e.g., 35 U.S.C. 365.¹ The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 371. Since applicant gave conflicting instructions, the papers should have been considered as having been filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 22 April 2005 were improperly accepted as a submission under 35 U.S.C. 371. Therefore, the portion of the decision mailed 13 February 2006 indicating that the application was being forwarded to the national stage office for preparation of a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) showing a 35 U.S.C. 371 date of 30 September 2005 is hereby VACATED. The application is deemed to have been filed under 35 U.S.C. 111(a).

¹Attention is also directed to MPEP 1893.03(c), which states in part:

Note: a national stage application filed under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See also MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a priority claim in the national stage to the international application is inappropriate. Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. 371.

Continuation Application

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/532,779) and the international application (PCT/EP03/11343) designating the United States were copending on 22 April 2005.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

This application is accepted as an application filed under 35 U.S.C. 111(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. 111(a).



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